

## REMARKS

In the Official Action, claims 3, 4, 7 and 8 were rejected under 35 U.S.C. 112, second paragraph, as indefinite. The remainder of claims 1 through 12 are allowed. The basis for the rejection under 35 U.S.C. 112 is the asserted double inclusion of "porous element" in each of the rejected claims.

By this amendment, claims 1, 2, 5 and 6 have been identically copied as filed and here presented as new claims 13, 14, 15 and 16, respectively. Claims 1 and 5 have been amended to remove the recitation of "porous element" and, thereby have been broadened to insure construction of the claim as not including a "porous element." Claims 13 and 15 which are identical to original claims 1 and 5, respectively, are here discussed in the context of the rejection.

Albeit claims 3, 4, 7 and 8 are rejected, the basis for the rejection speaks directly to the interpretation of claims 1 and 5, now claims 13 and 15, which numbers will be used for clarity. Claim 13 employs the phrase "porous element" in the preamble. Both claims 13 and 15 include the recitation "a porous element mount to receive a porous element fully across the path." It is Applicant's understanding of claims 13 and 15 that the functional phrase "to receive a porous element fully across the path" does not introduce a porous element as a further element of a claim, but rather provides definition to the porous element mount. It is with this understanding that claims 3, 4, 7 and 8 were appropriate for the introduction of a specific element, i.e., a porous element.

Applicant asserts that there are a number of points supporting this understanding. First, claims 13 and 15 are claims which define a device through a list of elements. These elements, a transmitter, a receiver, a chamber and a porous

element mount in claim 13, are appropriately recited in true antecedent basis.

Reference is made to 37 C.F.R. 1.75(i):

- (i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

The listed porous element mount is then further described by a function phrase, i.e., "to receive a porous element fully across the path." Functional limitations are appropriate, MPEP 2173.05(g):

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swineheart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

The clear utility of the functional phrase is to establish the capability of the porous element mount. The porous element mount does not extend fully across the path as that would interfere with the path. Rather, the mount is appropriately recited to receive the porous element such that such a porous element would extend fully across the path.

The plain English meaning of the claim includes a number of elements under the term "comprising". However, "to receive a porous element" uses the porous element as that which is capable of being received by the porous element mount. The porous element is not separately listed as an element under the term "comprising" or even as a sub-component of the porous element mount.

The context of the disclosure also supports the recognition of a detector and a material separator as distinguished from the porous element. In effect, the detector or the material separator may be considered analogous to a razor while the porous

element is analogous to a razor blade. All components with the exception of the porous element are expected to last for substantial periods of time. By contrast, the porous element is subject to abrasion, tearing the like, requiring periodic replacement. Such elements are also replaced to vary the function of the device to accommodate variations in screen particle size and other attributes and conditions to which the separator may be subjected. Indeed, the function of the detector is to determine failures in the porous element early on with the specific intention of timely replacement. This understanding is illustrated in paragraph [0018] in the Summary of the Invention. See also paragraph [0034] in the Detailed Description:

An analogous situation referenced in *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) is referenced in MPEP § 2111.02:

The claim at issue was directed to a driver for setting a joint of a threaded collar, however the body of the claim did not directly include the structure of the collar as part of the claimed article. The Examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The Court found that the collar structure could not be ignored. *While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver.* “[T]he framework – the teachings of the prior art – against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited.”

[emphasis added]

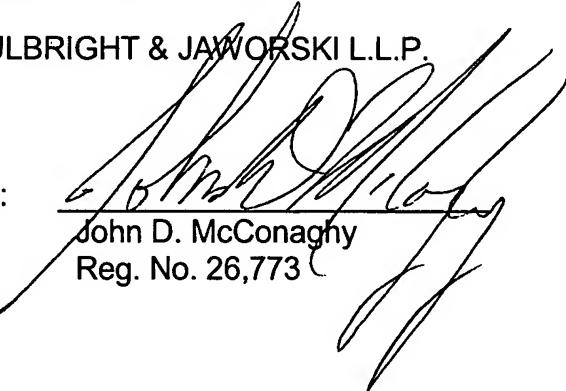
Thus, as in *In re Stencel*, the porous element is not specifically included, but rather the porous element mount is understood to be not all mounts broadly, but mounts suitable for use in combination with a porous element.

With the foregoing assertions also now part of the record, it is believed that claims 13 and 15 are appropriately formed and without ambiguity. Consequently, a Notice of Allowance is earnestly solicited.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

By:

  
John D. McConaghay  
Reg. No. 26,773

May 19, 2005

29<sup>th</sup> Floor  
865 South Figueroa Street  
Los Angeles, CA 90017-2576  
(213) 892-9200